

REMARKS

This reply accompanies a Request for Continuing Examination (RCE) and is in response to the Office Action mailed on March 9, 2007 in which claims 1-25 were rejected. Claims 12-15, 21, 23 and 25 are canceled; claims 1, 5, and 16 are amended; and claims 26-28 are added. Claims 1-11, 16-20, 22-23 and 26-28 are presented for reconsideration and allowance.

I. Examiner Interview Summary

On June 6, 2007, a telephonic interview is held between Examiner Blenman and Applicant's attorney, Todd A. Rathe. The rejections of claims 12, 21, 22 and 24 were discussed. It was tentatively agreed upon that the rejection of claim 22 and 24 under 35 USC 112, first paragraph should be withdrawn and that claims 22 and 24 are patently distinct over the prior art to record.

Applicants wish to thank Examiner Blenman for the opportunity to discuss the rejections.

II. Rejection of Claims 4-5, 12-15, 21-24 under 35 USC 112, first paragraph

Section 2 of the Office Action rejected claims 4-5, 12-15, 21-24 under 35 USC 112, first paragraph. Claims 12-15, 21 and 23 are canceled. As noted above, it was agreed upon during the Examiner Interview held on June 6, 2007 at the rejection of claims 22 and 24 under 35 USC 112, first paragraph should be withdrawn.

Applicants respectfully request that the rejection of claim 4 under 35 USC 112, first paragraph be withdrawn. The Office Action is failed to establish how the subject matter of claim 4 is allegedly not contained in the originally filed written description. The Office Action only addresses the limitations of claim 5. Accordingly, Applicants respectfully request of the rejection a claim 4 be withdrawn.

Claim 5 is amended to further recite that the noted time "stamps" are those associated with each message. As acknowledged in the Office Action, support for the recitation of a

time "stamp" is found in Paragraph [0038]. Applicants respectfully submit that one of ordinary skill in the art clearly understands what constitutes a time stamp, especially when referring to electronic mail messages. Accordingly, claim 5, as amended, is supported by the originally filed written description and the written disclosure does evidence possession of the claimed invention at the time of filing.

In rejecting claim 5, the Office Action appears to be equating a time stamp with any point in time. However, as one of ordinary skill in the art is aware, a time stamp is simply not any "point in time." The Office Action appears to be overlooking the limitation "stamp" which follows each occurrence of the limitation "time." As one of ordinary skill in the art knows and would recognize, in the context of the remaining disclosure of the present application, a time stamp is it time attached to a message when the message is sent or when it is received. Accordingly, Applicants respectfully request that the rejection acclaimed 5 under 35 USC 112, first paragraph be withdrawn.

III. Rejection of Claims 1-11, 16-20 and 25 under 35 USC 102(e) Based upon Tafoya

Section 3 of the Office Action rejected claims 1-11, 16-20 and 25 under 35 USC 102(e) as being anticipated by Tafoya et al. US Patent 6,829,607. Claim 25 is canceled. Claims 1-11 and 16-20, as amended, overcome the rejection based upon Tafoya.

A. Claim 1

Independent claim 1, as amended, recites a method of populating a contact list on a portable device and recites:

extracting contact information from a number of messages stored in a memory in the portable device; and

automatically entering the extracted contact information upon extraction into a contact list that is configured to receive information directly entered into the contact list by a person via a text entry device and that is maintained by a program operating on the portable device.

Support for the amendments to claim 1 may be found in at least Paragraph [0004] which identifies the OUTLOOK program sold by Microsoft Corp. as an example of a contact list. Applicants further refer to Figures 4-7 which further illustrates operation in Windows. As one of ordinary skill the art knows, OUTLOOK has a contact list which is configured to receive information directly entered into the contact list by a person via a text entry device. Thus, no new matter is believed to be added.

1. Tafoya fails to automatically update its "address book"/"contact listings"/"contact database."

Tafoya fails to disclose a method wherein contact information from a number of messages is extracted and is automatically entered upon extraction into a contact list that is configured to receive information correctly entered into the contact list by a person via a text entry device. In contrast, Tafoya extracts information and enter such information into a resolution list, not a contact list. A resolution list is not the same as a contact list. Tafoya itself makes this distinction clear. Tafoya repeatedly refers to its "resolution list" as being distinct from its "address book"/"contact listings"/"contact database". (See Tafoya, column 4, line 50-52; column 7, lines 31-35; 11, lines 23-25; column 13, lines 6-7; lines 24-29 and lines 32-34).

Moreover, although Tafoya does disclose that a user may selectively add resolution list entries to his or her address book or contact database, nowhere does Tafoya disclose automatically entering extracted contact information upon extraction into a contact list. Rather, Tafoya apparently requires an individual to go to the additional effort of (1) browsing the resolution list and (2) manually selecting such entries to be added to the contact list via a "push-button". (See Tafoya, column 13, lines 18-29).

One of the main objectives of Tafoya appears to be user convenience. As acknowledged by Tafoya, many e-mail users do not take the time to enter information into their e-mail address books/contact lists (see Tafoya, column 1, lines 63-65). If the user will not take the time to enter information into their contact list, the user will also probably not take the time to transfer information from Tafoya's resolution list to their contact list. Tafoya

fails to recognize that additional convenience may be achieved by automatically entering extracted contact information upon extraction into a contact list as Applicants have realized.

Moreover, Tafoya actually teaches away from automatically entering extracted contact information upon extraction into a contact list. As noted by Tafoya, any contact information already contained in the contact list is removed from the resolution list. (See Tafoya, column 13, lines 27-29). To hypothetically and alternatively automatically enter extracted contact information upon extraction into the contact list of Tafoya would eliminate Tafoya's resolution list. The entire focus of Tafoya is its resolution list. As noted by MPEP 2143.02, THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE and THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE. Since modifying Tafoya to alternatively automatically enter extracted contact information upon extraction into a contact list would substantially change the principle of operation of Tafoya, it would not be obvious to modify Tafoya in such a manner.

2. Tafoya's resolution list cannot be characterized as a "contact list" since it does not permit a person to directly enter information into it via a text entry device.

In response to such previous points, the Final Office Action asserts that the resolution list of Tafoya comprises a contact list. However, the resolution list of Tafoya is NOT configured to receive information directly entered into the contact list by a person via a text entry device. The only manner by which information may be added to the resolution list of Tafoya is by extracting information from messages. Information cannot be directly entered into the contact list by a person. Accordingly, the resolution list of Tafoya cannot be properly characterized as the contact list into which extracted contact information is automatically entered. Accordingly, Claim 1, as amended, overcomes the rejection based upon Tafoya. Claims 2-10 depend from claim 1 and overcome the rejection for the same reasons.

B. Claim 5

Claim 5 depends from claim 1 intervening claim 4. Claim 5, as amended, recites that only messages sent or received before a preselected time stamp associated with each message, after a preselected time stamp associated with each message or during a preselected time period between two time stamps associated with each message are scanned for contact information extraction. Support for the amendment to claim 5 may be found in at least Paragraph [0038]. Thus, no new matter is added.

Tafoya fails to disclose that only messages sent or received before a preselected time stamp associated with each message, after a preselected time stamp associated with each message or during a preselected time period between two time stamps associated with each message are scanned. In contrast, Tafoya requires the entire "data store" to be scanned each time the program information module (PIM) is started. (See Tafoya, column 9, lines 53-56). Thereafter, as a user enters new e-mail addresses while the PIM is active, the resolution list is updated. Tafoya does not disclose scanning a message database for contact information extraction based upon time stamps of the messages. Accordingly, claim 5, as amended, overcomes the rejection based upon Tafoya.

C. Claim 16

Independent claim 16, as amended, is directed to a processing system and recites, among other limitations:

a storage device . . . having stored there information for configuring the CPU to:

extract contact information from a number of messages stored in a memory in the portable device; and

enter the extracted contact information into a contact list maintained by a program operating on the portable device,  
wherein only a portion of a contact entry for an individual entity is modified with the extracted information or is replaced with the extracted information.

Support for the amendment to claim 16 may be found in at least Paragraph [0034] of the present application. Thus, no new matter is believed to be added.

Tafoya fails to disclose the entering of contact information into a contact list, wherein only a portion of a contact entry for an individual entry is modified with the extracted information or is replaced with the extracted information. As noted above with respect to the rejection of Claim 1, Tafoya clearly distinguishes a contact list (aka, contact database, address book) from a resolution list. Although Tafoya does disclose transferring information from the resolution list to the contact list, Tafoya only discloses that an entire resolution list entry is added to the contact database. In particular, Tafoya specifically states:

While browsing the resolution list, the user interface preferably allows the user to selectively add entries 550 from the list to his or her address book or contact database.

(Tafoya, column 13, lines 24-27). Nowhere does Tafoya disclose modifying only a portion of a contact entry for an individual entity or replacing only a portion of a contact entry for an individual entity using extracted information. Accordingly, claim 16, as amended, overcomes the rejection based upon Tafoya. Claim 17-20 depend from claim 16 and overcome the rejection for the same reasons.

#### IV. Added Claims

With this response, claims 26-28 are added. Claims 26-28 are believed to be patentably distinct over the prior art of record.

##### A. Claim 26

Claim 26 depends from claim 16 and further recites that the extracted information is automatically entered into the contact list to modify a portion of a contact entry for an individual entity. The prior art of record failed to disclose such a processing system. Accordingly, claim 26 is presented for consideration and allowance.

##### B. Claims 27 and 28

Claim 27 depends from claim 1. Both claims 27 and 28 recite that only a portion of a contact entry for an individual entity is modified or is replaced with the entered extracted contact information. Support for such added claims may be found in at least Figure 5 and

related disclosure.. The prior art of record fails to disclose or suggest such a method. Accordingly, claims 27 and 28 are presented for consideration and allowance.

V. Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-3815. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-3815. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-3815.

Respectfully submitted,

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By Todd A. Rathe

RATHE PATENT & IP LAW  
Customer Number: 59555  
Telephone: (262) 478-9353  
Facsimile: (262) 238-1469

Todd A. Rathe  
Attorney for Applicant  
Registration No. 38,276